

REMARKS

An excess claim fee payment letter is submitted herewith for one (1) additional independent claim and three (3) additional total claims.

Claims 1-23 are all the claims presently pending in the application. Claims 1-3 are amended to more clearly define the invention and claims 4-23 are added. Claims 1, 4, 11, and 15 are independent.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicants also note that, notwithstanding any claim amendments herein or later during prosecution, Applicants' intent is to encompass equivalents of all claim elements.

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lin reference in view of the Obergfell, et al. reference.

This rejection is respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

A first exemplary embodiment of the claimed invention, as defined, for example, by independent claim 1, is directed to a box nailing machine that includes a box nailing machine body having a nail driving port from which nails are driven, a handle portion having a handle arm, and a magazine for accommodating nails, a forward end portion of which is attached to the nail driving port. A portion of the magazine except for the forward end portion being attached to

the handle portion via the handle arm. The magazine has a handle arm attaching portion for attaching the magazine to the handle arm. The magazine is made of metal and is formed substantially into a U-shape by press forming. A washer is integrally formed in the handle arm attaching portion so that the washer is disposed between a head portion of a fixing bolt and the magazine.

A second exemplary embodiment of the claimed invention, as defined, for example, by independent claim 4, is directed to a magazine for a box nailing machine that includes a U-shaped metallic plate, and a washer fixed to an inner wall of the metallic plate.

A third exemplary embodiment of the present invention, as defined, for example, by independent claim 11, is directed to a method of manufacturing a magazine for a box nailing machine. The method includes fixing a washer to a wall of a metallic plate, and press-forming the metallic plate into a U-shape.

Conventional box nailing machines that include a U-shaped metallic magazine have either fixed the magazine directly to a handle arm or attached the magazine using a plurality of bolts.

The conventional box nailing machines that fixed the magazine directly to the handle arm required replacement of the magazine even when only the handle arm was broken.

The conventional box nailing machines that attached the magazine to the handle arm using a plurality of bolts required either a plurality of washers that made assembly difficult or a plate washer that required a large opening in a side of the magazine that reduced the strength of the magazine.

In stark contrast, the first exemplary embodiment of the present invention is box nailing machine that provides a washer that is integrally formed in the handle arm attaching portion, the second exemplary embodiment of the present invention is a magazine for a box nailing machine that provides a washer that is fixed to an inner wall of the magazine and the third exemplary embodiment of the present invention is a method for manufacturing the magazine by fixing a washer to a wall of a metallic plate, and press-forming the metallic plate into a U-shape. In this manner, assembly of the magazine to a box nailing machine is greatly simplified.

II. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

The Examiner alleges that claims 1-3 are indefinite. While Applicants submit that such would be clear to one of ordinary skill in the art taking the present Application as a whole, to speed prosecution claims 1-3 have been amended in accordance with Examiner Chukwurah's very helpful suggestions.

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

III. THE PRIOR ART REJECTION

The Examiner alleges that the Obergfell et al. reference would have been combined with the Lin reference to form the claimed invention. Applicants submit, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicants thank Examiner Chukwurah for the courtesies extended to the Applicants' representative during a telephone conference on September 22, 2004. The Applicants' representative contacted the Examiner to inquire whether the first full paragraph on page 3 of the September 9, 2004, Office Action included a typographical error or not.

In particular, the Applicants' representative pointed out to Examiner Chukwurah that the Office Action does not provide any disclosure of a washer integrally formed in the handle arm attaching portion of the magazine as recited by, for example, independent claim 1, and that there is no motivation to modify the disclosure in the Lin reference for the purpose of providing "support to the fixing bolt" when the Examiner admits that the Lin reference already "provides support to the fixing bolt."

In response, Examiner Chukwurah agreed that "something is missing" from the rejection and that the "error would be corrected" after receiving a written response to the Office Action.

Applicants respectfully submit that the September 9, 2004, Office Action does not provide a prima facie case of obviousness, as admitted by Examiner Chukwurah, and respectfully requests withdrawal of the rejection.

Applicants submit that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, the Lin reference is directed to stably securing a nail engaging bar in a cassette and preventing the bar from becoming easily worn out (col. 1, lines 18-23; and col. 2, lines 47 - 55).

In stark contrast, the Obergfell et al. reference is specifically directed to the completely

different problems of providing a lower cost method for manufacturing a magazine, preventing ingestion of outside air into the cylinder during a return stroke, positively feeding a fastener strip, readily loading the magazine and preventing operation of the tool upon depletion of the supply of fasteners (col. 2, lines 6 - 24).

One of ordinary skill in the art who was concerned with the problems of stably securing a nail engaging bar in a cassette and preventing the bar from becoming easily worn out as the Lin reference is concerned with solving would not have referred to the Obergfell et al. reference because the Obergfell et al. reference is concerned with the completely different problems of providing a lower cost method for manufacturing a magazine, preventing ingestion of outside air into the cylinder during a return stroke, positively feeding a fastener strip, readily loading the magazine and preventing operation of the tool upon depletion of the supply of fasteners.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner does not even support the combination by identifying a reason for combining the references.

As agreed by Examiner Chukwurah during the September 22, 2004, telephone interview, one of ordinary skill in the art would not have been motivated to modify the disclosure of the Lin reference for the purpose of providing "support to the fixing bolt" because as the September 9, 2004, Office Action admits, the assembly disclosed by the Lin reference already "provides support to the fixing bolt." Therefore, clearly one of ordinary skill in the art would not have been motivated to modify the disclosure of the Lin reference as alleged by the Office Action.

Even assuming arguendo that one of ordinary skill in the art would have been motivated

to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

None of the applied references teaches or suggests the features of the claimed invention including: 1) a washer that is integrally formed in the handle arm attaching portion (claim 1); 2 a washer fixed to an inner wall of the metallic plate (claims 4, and 15); and 3) fixing a washer to a wall of a metallic plate, and press-forming the metallic plate into a U-shape (claim 11). As explained above, these features are important for greatly simplifying assembly of the magazine to a box nailing machine.

The Office Action and the Examiner admits that the Lin reference discloses a washer that is “not integrally formed in the handle arm attaching portion” of the magazine. Indeed, the Lin reference clearly does not teach or suggest fixing the washer to the inner wall of the metallic plate, let alone integrally forming the washer in the handle arm attaching portion as admitted by the Examiner.

The Obergfell et al. reference clearly does not remedy the deficiencies of the Lin reference. Indeed, the Examiner does not allege that the Obergfell et al. reference remedies these deficiencies.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1-3.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that claims 1-23, all the claims presently pending in the Application, are patentably distinct over the

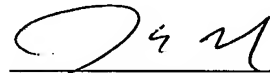
prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 12/9/04


James E. Howard
Registration No. 39,715

McGinn & Gibb, PLLC
8321 Old Courthouse Rd., Suite 200
Vienna, Virginia 22182
(703) 761-4100
Customer No. 21254